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EXAMINER

FLANIGAN, ALLEN J

ART UNIT

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3743

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 16

Application Number: 09/650,335
Filing Date: August 28, 2000
Appellant(s): GIACOMEL, JEFFREY A.

William R. Gustavson
For Appellant

MAILED
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GROUP 3700

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/29/02.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1, 2, 4, 6, 7, 20, 21, 22, and 23 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(9) Prior Art of Record

3,229,757

ROOT ET AL.

1-1966

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 4 are indefinite because the intended scope of these claims has not been made clear. The claims recite an “apparatus for rapidly changing the temperature of a mass of product”, implying that the mass of product is not within the scope of the claim, but is an element which the claimed device can be utilized to modify. Yet subsequent recitations in claim 1 of “heat transfer elements extending into the mass of product” imply that the mass of product is indeed an element of the claim. Similarly, the recitation in claim 4 that at least one heat transfer element is “contacting the bottom of the pan”, said pan containing the mass of product, again implies that the mass of product is meant to be a positively recited element of the claim in spite of its recitation in the preamble of claim 1 in a manner which implies that it is not a part of the claimed “apparatus”.

Claims 1, 2, 6, 7, 20, 22, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Root et al.

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Root shows every element of the claimed apparatus, including “at least two input heat transfer elements . . . being in parallel spaced planes” (any of the plural fins a, b, c, d, w, x, y, z), and “at least one output heat transfer element in thermal contact with the input heat transfer elements” (any of the plurality of fins on the opposite side of web members 17, 18 from the upstanding fins a-z). It is “commonly extruded from aluminum or other heat conductive metal” (lines 9-11, column 2). It is formed as a unitary body. The fins are clearly rectangular as shown in the drawings.

The recitations that the heat transfer elements extend “into the mass of product”, and that the output heat transfer element is “exposed to an ambient temperature environment to transfer thermal energy between the product mass and the ambient temperature environment” are clearly recitations which concern the intended use of the claimed device (see lines 5-7 and lines 19-22 of page 8 of the specification), and at most require that the prior art be capable of use in the recited manner. Root et al. clearly can be used to contact a material and cool it in light of the structural similarity between the disclosed invention and the heat dissipation apparatus of Root et al.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Root et al.

In the Office action dated 8/21/01 (Paper Number 9), the Examiner took Official Notice of the fact that “the use of coatings of highly heat conductive materials (such as diamond or copper) on heat transfer surfaces is of such

notorious character in the art that citation of a reference is unnecessary". Since the appellant did not seasonably challenge this assertion, the object of the well known statement is taken to be admitted prior art. ***In re Chevenard*, 60 USPQ 239.**

(11) Response to Argument

112 rejection

"The primary purpose of [the second paragraph of 35 U.S.C. 112] of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent." MPEP 2173. It is this lack of certainty regarding scope that prompts the rejection under 35 U.S.C. 112, second paragraph. As the appellants themselves admit on page 5 of the Brief, "Claim 1 does not intend to claim the product itself that the apparatus is designed to cool". Appellants further admit on page 6 that "Neither the mass of the product nor the pan are elements of claim 4". Appellant is correct in pointing out that there "is no error in setting forth how the claimed apparatus interacts with the mass of product" in use. In looking at claim 22, for example, this claim sets forth this interaction in a manner that does not render the claim indefinite. Claim 22 recites that the input heat transfer elements are "for insertion within the mass of product". This defines the desired relationship when the product is used without confusing the issue by implying that the mass of product is an actual claimed element. If claim 1 is not meant to encompass the mass of product

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within its scope as a positively recited element as appellants admit, then it should recite that the input heat transfer elements are “extendable into the mass of product”, not that they are “extending into the mass of product”.

Anticipation rejection

The Examiner has pointed out previously that anticipation does not require that the prior art teaches what the subject application teaches, but only that the claim “read on” something disclosed in the reference. ***Kalman v. Kimberly Clark Corp.*, 218 U.S.P.Q. at 789**. In this instance, the claims read on the heat dissipator structure shown in Root et al. Root et al. admittedly did not conceive of using his fin structure to cool a “mass of product”, but “The method of using a device is immaterial to the question of patentability of claims directed to structure of the device.” ***In re Keegan*, 141 U.S.P.Q. 512; see also *In re Lampert*, 114 U.S.P.Q. 163; *In re Casey*, 152 U.S.P.Q. 235; *In re Otto*, 136 U.S.P.Q. 458**.

Appellant’s comments on page 6 of the Brief that Root et al. “does not disclosed at least two input heat transfer elements in parallel spaced planes” ignores structure clearly shown in Root et al. (see comments made in the rejection on page 4 above, pointing to members a, b, c, d, w, x, y, z).

Appellant urges that the intended use of the disclosed device “is not the issue here”. With all due respect, the Examiner submits that this is precisely the issue. The disclosure makes clear that the structural requirements of a device suitable for use to cool a “mass of product” is at least one element

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thermally contacting at least a pair of additional elements. The illustrative embodiment of Fig. 16, for example, shows a metal apparatus having parallel rectangular members extending from a central web on either side, and this is what Root et al. show. No additional structure appears to be required to make the disclosed device suitable for changing the temperature of a mass of product into which the device is to be inserted.

The comment at the bottom of page 6 is not commensurate in scope with the claim. Claim 6 is not limited to the use of stainless steel, cast iron, or copper, but also includes the use of aluminum. Similarly, the comments on claim 7 are in no wise commensurate with the claims. Nothing in the claims requires the device to be "suitable for use with food under relevant health and safety codes". Notwithstanding, it is clear that aluminum is suitable for use with food; cooking pans are commonly made of aluminum, for example.

Appellant cites *In re Venezia* for the proposition that "the structure of a component can be defined in terms of the attributes it possesses". This is true, and Root et al., as pointed out previously, clearly possesses the attribute of being capable of being inserted into a mass of material. Root et al. may have not appreciated or disclosed explicitly this attribute, but recognizing in the prior art attributes which others failed to detect does not entitle the appellant to repatent a known structure. ***In re Lawson*, 108 U.S.P.Q. 132.**

Finally, the claimed coating of claim 21 fails to patentably distinguish in that the appellant has admitted that the use of such coatings is well known in

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the art; he cannot now assert otherwise in an attempt to overcome the *prima facie* case of obviousness.

Conclusion

Appellant's claims are drawn to a structure; Root et al. show a device that is *structurally indistinguishable* from the structure set forth in the appealed claims. Appellant has failed to point to any *structural* distinction set forth in the claims that cannot be met by an element of the structure of Root et al.


For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Allen J. Flanigan
Primary Examiner
Art Unit 3743

AJF
December 9, 2002

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